

**PATENT APPLICATION
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SUBJECT:	PRINTING SYSTEM WITH NOTIFICATION FUNCTION		

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SIR:

APPELLANTS'/APPLICANTS' REPLY BRIEF

The Appellants filed an opening brief on September 14, 2007. The Examiner mailed an Answer December 13, 2007. The following is a reply to the Examiner's Answer.

1. GROUNDS FOR REJECTION TO BE REVIEWED.

A. Claims 1-8, 10-11, 13-17, and 19-24 stand rejected under 35 U.S.C. §102 as being anticipated by USPN 6,975,419 issued to Staas.

B. Claim 9 stands rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 6,978,313 issued to Pietrowicz.

C. Claims 12 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 5,751,961 issued to Smyk.

2. ARGUMENT.

A. Ground For Rejection A – Claims 1-8, 10-11, 13-17, and 19-24 stand rejected under 35 U.S.C. §102 as being unpatentable over USPN 6,975,419 issued to Staas.

Claim 1 is directed to a method of transmitting a message and recites the following elements:

- a) determining if a device encounters an event while processing a job;
- b) determining if the job meets a pre-determined criterion; and
- c) transmitting a message to a remote destination when each of a set of pre-determined conditions exist, the pre-determined conditions include:
 - a. determination that the device encountered the event while processing the job; and
 - b. a determination that the job met the pre-determined criterion.

In the opening Brief, the Appellant explained that Staas fails to teach or suggest a method that includes transmitting a message to a remote destination when each of a set of pre-determined conditions exist, where the pre-determined

conditions include: a determination that the device encountered the event while processing the job; and a determination that the job met the pre-determined criterion. To aid in the following discussion, attention is drawn to particular sections of the Specification to bring meaning to the term "event" and the phrase "pre-determined criterion" as they are used in Claim 1.

Page 13, lines 16-22 provide examples of what is meant by the term "event." In particular, an event is an event experienced by a device processing a job. The event can be an error, a job failure, or a job completion. Fig. 7 and Page 15, line 26 through page 16, line 2 provide examples of pre-determined criterion. In particular a pre-determined criterion may be any criterion that can be specified for the job. Examples include document characteristics such as number of pages, page sizes, and font sizes. A criterion may also be a print setting such as a direction to print in color. This is in line with the dictionary definition of criterion found at Merriam-Webster's online dictionary at m-w.com. The term criterion is defined as "a characterizing mark or trait." Thus, a print job criterion is a characterizing mark or trait of that print job. Therefore, with respect to claim 1, an event is particular to a device processing a job without regard to the job itself. A criterion is particular to the job itself without regard to the device.

In the opening brief, the Appellant explained that Staas Figs. 3A and 3B illustrate a method in which a message is transmitted if there exists an event in the form of a rendering error with respect to a print job. However, the method illustrated in that figure does not include determining if that print job itself meets a pre-determined criterion as a prerequisite for sending that message. In short the method of Figs. 3A and 3B involve transmitting a message on the occurrence of an event in the form of an error without regard to a determination of whether or not the print job itself meets a predetermined criterion.

The Appellant also noted that Staas, Figs. 6A and 6B illustrate a method for retrieving and printing a document referenced in an e-mail request. Step 446 involves determining if the e-mail request is of a proper format. If not a message is sent in step 459. Step 443 simply involves a determination as to whether or not a job (e-mail request) meets a pre-determined criterion (improper format). If so the message is sent in step 459. In short steps 443 and 459 of Figs. 6A

involve transmitting a message upon a determination that a job meets a criterion without regard to a determination of whether or not the device processing the request has encountered an event while processing the job.

Step 456 involves determining if the file indicated in the e-mail request can be found. If not a message is sent in step 459. Staas step 456 is simply a determination of whether a file referenced in an e-mail request can be found. With respect to Claim 1, step 456 is at best a determination as to whether a device has encountered an event – that event being an inability to find a file. Staas' step 456 has nothing to do with determining if the file or email request meets a predetermined criterion. As such the message of step 459 is sent without regard to a determination of whether or not the job itself meets a predetermined criterion.

Step 463 involves determining if the e-mail request is a forwarding request. If so, a message with the requested file attached is forwarded to a third party in steps 466, 473 and 476. If not, a message with the requested file attached, is returned to the requestor in steps 469, 473, and 473. In short a forwarding or reply message is sent based upon a determination as to whether the e-mail request is of a pre-determined (forwarding) format without regard as to whether a device processing the request has encountered an event.

The Examiner responded at pages 5-7 of the Answer. Initially, the Examiner states, at page 6, that the Appellant argued that Staas is merely directed to the printing of an e-mail. This is plainly not the case. The Appellant was simply referring to sections of Staas' abstract and summary sections to explain an overriding scope of Staas' disclosure. Clearly, Staas Figures 3A, 3B, 6A, and 6B, as noted above, illustrate more than simply printing an e-mail. Nonetheless, the goal of Staas' disclosure remains the same.

Referring to the carry-over paragraph spanning pages 6 and 7 of the answer, the Examiner goes on to state the following:

Appellants argued that Staas does not teach sending a message to a sender when an event is encountered and (Appellants' emphasis) a criterion is met. The Examiner disagrees. In lines 9-22 of page 13

of the specification, Appellants define what "events" are. The term "events" is defined as: any type of error or alert condition, including failure or successful (Examiner's emphasis) of the print job. Obviously, a print job can not be successful if criterion is not met. Therefore the definition of event as defined in the specification includes the definition of criteria. Staas teaches, in Figure 38 that a message is sent to a user if the print job is successful (346). Again, a print job can not be successful if criterion is not met. Therefore, when a successful message is sent in Staas, an event (the event of successful) has occurred and all criteria are met (the print job is successful).

The examiner's assertion that the definition of event includes the definition of "criteria" is false. As noted above, an event encountered by the device processing the job is unique to the device and can be an error, a job failure or a job completion. A pre-determined criterion unique to the job and can be a number of pages, a page size, a font size, or a particular setting such as a direction to print in color. Claim 1 expressly recites (a) an event encountered by a device while processing a job and (b) a pre-determined criterion corresponding to the job. Plainly one must presume that the two are different. Otherwise, the Claim and the Specification would not have distinguished between the two.

The Examiner also states at page 7 of the Answer:

Appellants fail to provide any arguments as to why the feature of sending a message only when there is an event (error) occurred and when a criterion is met is patentably distinct with respect to the applied art. Appellants fail to give at least one example of the situation and identifying what the message would indicate to the sender in this situation.

These statements are misleading. The test for anticipation is not whether a limitation of a claim is patentably distinct. To satisfy the requirements of §102, the Examiner must establish that a prior art reference teaches or suggest each and every limitation of a claim. Failure to do so renders the claim as a whole patentably "distinct with respect to the applied art." Furthermore, the Applicant, perhaps improperly, assumed that the Examiner would look to the Specification to

find the noted example. One need look no further than page 1, lines 15-24 which are reproduced below.

Even if a mechanism were available to notify the user at these various locations, however, whether or not a user would *want* to be notified may depend on his/her personal preferences.

Consider the following example. Suppose a user submits a job at his/her place of business. While the job is printing, the user then goes home. While the user is at home, the printer processing the job encounters a job failure. In this example, the user may or may not wish to be notified at home of the job failure. This may depend on how important it is to the user that the job successfully prints.

With these paragraphs in mind, the message recited in Claim 1 could be a message indicating a job failure. However, the message is only sent if the particular job in question is of a particular importance. That importance exists if the job meets a pre-determined criterion.

The Appellant respectfully maintains that Staas fails to teach or suggest a method that includes transmitting a message to a remote destination when each of a set of pre-determined conditions exist, where the pre-determined conditions include: a determination that the device encountered the event while processing the job; and a determination that the job met the pre-determined criterion.

For at least these reasons, Claim 1 is patentable over Staas as are Claims 2-9 due at least in part to their dependence from Claim 1.

Claim 10 is directed to a method of transmitting a message and recites the following elements:

- a) receiving input that specifies at least one print job criterion and an e-mail address;
- b) submitting a print job to a printer for processing;
- c) determining if a device encounters an event while processing a job;
- d) determining if the job meets the pre-determined criterion; and

- e) if it is determined that the print job meets the at least one print job criterion and that the printer encountered an event while processing the print job, then transmitting an e-mail message to the e-mail address.

In the opening brief, the Applicant explained that Staas failed to teach or suggest (1) determining if a device encounters an event while processing a job, (2) determining if the job meets the pre-determined criterion, and then (3) sending of an e-mail message to the e-mail address (*the same e-mail address received in step a)* if it is determined that the print job meets the at least one print job criterion and that the printer encountered an event while processing the print job. Responding at page 7 of the Answer, the Examiner states:

"Appellants rely on the same feature in claim 1 for patentability. Claim 10 therefore stand or fall with claim 1.

Clearly, Claim 10 recites limitations not found in Claim 1. For example, Claim 10 recites "receiving input that specifies at least one print job criterion and an e-mail address" while Claim 1 does not. In the opening brief, the Appellant addressed these limitations. As such, the Appellant, with respect to Claim 10, did not "rely on the same feature in claim 1 for patentability."

The Appellant respectfully maintains that Staas mentions nothing of receiving input that specifies at least one print job criterion and an e-mail address. For at least these reasons, Claim 10 is patentable over Staas as are Claims 11-14 due at least in part to their dependence from Claim 10.

Claim 15 is directed to a computer readable medium embodying a program of instructions for causing a computer to perform the followings:

- (a) receiving a request from a user to print a document;
- (b) in response to the request, performing the following substeps:
 - (i) accessing the document to determine if the document has at least one characteristic;

- (ii) submitting a print job that describes the document to a printer;
- (iii) determining if the printer encounters an event while processing the print job; and
- (iv) if it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

As clarified above with respect to Claims 1 and 10, Staas simply does not teach or suggest if it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

For at least these reasons, Claim 15 is patentable over Staas as are Claims 16-18 due at least in part to their dependence from Claim 15.

Claim 19 is directed to a computing system that includes the following elements:

- a) means for receiving input from a user that specifies at least one print job criterion;
- b) means for receiving a request from the user to submit a print job to a printer;
- c) means for responding to the request by submitting the print job to the printer;
- d) means for determining if the print job meets the criterion;
- e) means for determining if the printer encounters an event; and
- f) means for transmitting a message to an address upon a determination that the print job meets the criterion and that the printer has encountered the event.

As clarified above with respect to Claim 1, Staas simply does not teach or suggest means for transmitting a message to an address upon a determination that the print job meets the criterion and that the printer has encountered the event.

For at least these reasons, Claim 19 is patentable over Staas as are Claims 20-24 due at least in part to their dependence from Claim 15.

C. Claims 12 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 5,751,961 issued to Smyk.

B. Ground For Rejection B – Claim 9 stands rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 6,978,313 issued to Pietrowicz.

Claim 9 depends from Claim 1 and includes all the limitations of that base claim. For at least the same reasons Claim 1 is patentable, so is Claim 9.

C. Ground For Rejection C – Claims 12 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over USPN 6,975,419 issued to Staas in view of USPN 5,751,961 issued to Smyk.

Claims 12 and 18 depend from Claims 10 and 15 respectively. For at least the same reasons Claims 11 and 15 are patentable, so are Claims 12 and 18.

For the reasons set forth above, Claims 1-24 are patentable over the cited references and are in condition for allowance.

Respectfully submitted,
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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. (previously presented) A method of transmitting a message, the method comprising:
determining if a device encounters an event while processing a job;
determining if the job meets a pre-determined criterion; and
transmitting a message to a remote destination when each of a set of pre-determined conditions exist, the pre-determined conditions include:
a determination that the device encountered the event while processing the job; and
a determination that the job met the pre-determined criterion.
2. (original) The method of claim 1, wherein the device is a printer and the job is a print job.
3. (previously presented) The method of claim 2, wherein determining if a device encounters an event comprises determining if a device encounters a job failure.
4. (previously presented) The method of claim 2, wherein determining if a device encounters an event comprises determining if a device encounters a successful completion of the print job.
5. (previously presented) The method of claim 2, wherein determining if the job meets a pre-determined criterion comprises determining if the print job directs the printer to print at least a threshold number of pages.
6. (previously presented) The method of claim 2, wherein transmitting the message comprises transmitting a message that indicates that the event has occurred.

7. (original) The method of claim 2, furthering comprising:
receiving input from a user that specifies the print job criterion and the location of the remote destination; and
in response to a request received from the user, submitting the print job to the printer.

8. (previously presented) The method of claim 7, wherein transmitting the message comprises transmitting an e-mail message.

9. (previously presented) The method of claim 7, wherein transmitting the message comprises transmitting the message to the remote destination in a manner that results in the user being paged.

10. (previously presented) A method of transmitting a message, comprising:

- (a) receiving input that specifies at least one print job criterion and an e-mail address;
- (b) submitting a print job to a printer for processing;
- (c) determining if a device encounters an event while processing a job;
- (d) determining if the job meets the print job criterion; and
- (e) if it is determined that the print job meets the at least one print job criterion and that the printer encountered an event while processing the print job, then transmitting an e-mail message to the e-mail address.

11. (previously presented) The method of claim 10, wherein transmitting comprises transmitting an e-mail message that indicates that the printer has encountered the event.

12. (previously presented) The method of claim 10, wherein transmitting comprises transmitting an e-mail message that includes a selectable hyperlink to a Web page that provides information regarding the event.

13. (previously presented) The method of claim 10, wherein determining if the device encounters an event comprises determining if the device encounters a job failure.

14. (previously presented) The method of claim 10, wherein determining if the device encounters an event comprises determining if the device encounters a successful completion of the job.

15. (original) A computer readable medium embodying a program of instructions for causing a computer to perform method steps, the method steps comprising:

- (a) receiving a request from a user to print a document;
- (b) in response to the request, performing the following substeps:
 - (i) accessing the document to determine if the document has at least one characteristic;
 - (ii) submitting a print job that describes the document to a printer;
 - (iii) determining if the printer encounters an event while processing the print job; and
 - (iv) if it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

16. (Previously Presented) The computer readable medium of claim 15 wherein the message is an e-mail message and commanding comprises commanding the device to transmit the message to an e-mail address.

17. (cancelled) The computer readable of claim 15, wherein the device is the printer.

18. (Previously Presented) The computer readable medium of claim 15, wherein the program of instructions comprises Web content.

19. (previously presented) A computing system, comprising:

- (a) means for receiving input from a user that specifies at least one print job criterion;
- (b) means for receiving a request from the user to submit a print job to a printer;
- (c) means for responding to the request by submitting the print job to the printer;
- (e) means for determining if the print job meets the at least one print job criterion;
- (e) means for determining if the printer encounters an event; and
- (f) means for transmitting a message to an address upon a determination that the print job meets the at least one print job criterion and that the printer has encountered the event.

20. (Previously Presented) The computing system of claim 19, further comprising:

- (e) means for receiving input from the user that specifies the address.

21. (previously presented) The computing system of claim 20, wherein the means for determining if the printer encounters an event comprises means for determining if the printer encounters a job failure.

22. (previously presented) The computing system of claim 21, wherein the means for transmitting a message comprises a means for transmitting an e-mail message to an e-mail address.

23. (previously presented) The computer system of claim 19, wherein the means for determining if the printer encounters an event comprises means for determining if the printer encounters a paper jam condition.

24. (previously presented) The computer system of claim 19, wherein the computer system includes a computer connected to the printer over a network.